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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Patent Application of

TAN et al.

Appln. No. 09/914,184

Filed: November 16, 2001

Confirmation No. 9483

Atty. Ref.: 117-363

T.C. / Art Unit: 1623

Examiner: D. Khare

FOR: SYNERGISTIC COMBINATION FOR TREATMENT OF VIRAL-MEDIATED DISEASES

* * *

PETITION UNDER 37 CFR §§ 1.144 and 1.181

January 5, 2005

Mail Stop Petition
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants petition the Director to invoke his supervisory authority and to modify the Examiner's final restriction requirement. In accordance with M.P.E.P. § 1002.02(c), it is understood that authority to decide this petition may be delegated to a Technology Center Director.

ISSUE IS RIPE FOR REVIEW

In the Office Action mailed October 3, 2003, the Examiner required restriction of claims 22-39. Applicants elected Group II (claims 22-29 and 38) and requested reconsideration in the Response filed November 3, 2003. It was requested that Group I (claims 30 and 39) also be examined in this application because claims 22-30 and 38-39 are so linked as to form a single general inventive concept. The Examiner did not dispute that a "single general inventive concept" linked the claims of Groups I and II, but the restriction requirement was still made final in the Office Action mailed April 16, 2004.

Claims 40-41 were added by Applicants in the Amendment filed August 16, 2004. A second Office Action was mailed November 15, 2004: claims 22-29, 38 and 40-41 (Group II) were substantively examined but claims 30 and 39 (Group I) remained withdrawn from consideration by the Examiner.

The claims were restricted into three groups. Applicants elected Group II with traverse. It is respectfully requested that the Director invoke his supervisory authority and modify the Examiner's restriction requirement so that claims 22-30 and 38-41 are examined in this application.

This petition is timely because the restriction requirement has been made final and an appeal has not yet been filed in this application.

STATEMENT OF FACTS AND POINT(S) TO BE REVIEWED

This application was filed under 35 U.S.C. § 371 as a U.S. national stage of Int'l Appln. No. PCT/US00/04699. The Examiner's restriction requirement is reviewed under "unity of invention" practice. PCT Rule 13.

It was stated in the Office Action mailed October 3, 2003 that Groups I and II are related as product and process of making. The claims of Groups I and II are clearly linked because the methods of Group II (claims 22-29, 38 and 40-41) require use of the products of Group I (claims 30 and 39). The "special technical feature" is the combination of (a) an interferon and (b) at least one compound selected from the group consisting of compounds having the formula (I) or (V) and their derivatives which is required in both Groups I and II. Claim 22 of Group II concerns a method of treating a flavivirus or rhabdovirus infection comprising administration of an interferon and at least one compound (b). Claim 30 of Group I concerns a product containing an interferon and at least one compound (b) for use in treating a flavivirus or rhabdovirus infection. This same special technical feature is involved in all of the claims of both Groups I and II, and it defines a contribution which the claimed invention makes over the prior art.

The Examiner argued that Groups I and II form distinct inventions because "the process for using the product can be practiced with another materially different product (MPEP §806.05(h))." Applicants disagree. The process is a method of treatment (e.g., claim 22) and relates to one way in which the specified infections may be treated. Of course, products which can be used in a method to treat a flavivirus or rhabdovirus infection other than those of the present invention might exist. The Examiner presented

the mixture of antiviral interferon proteins of U.S. Patent 5,676,942 as an example of one such "materially different product." But these materially different products cannot be used in the claimed method of treatment!

The Examiner alleged in the Office Action mailed April 16, 2004 that searching the claims of Groups I and II would be unduly burdensome. Applicants disagree. But even if this is true, the burden to search claims 22-30 and 39-41 is irrelevant to consideration of whether the Examiner's restriction requirement is proper. If claims 22-30 and 39-41 are so linked as to form a single general inventive concept, restriction is improper because there is unity of invention in accordance with PCT Rule 13.

The product of claim 30 defines an interferon and at least one compound (b) for the treatment of a flavivirus or rhabdovirus infection. The claimed product is used in the process of claim 22. It follows that if a search is performed on the presently claimed product to establish its novelty and non-obviousness, use of the claimed product for the treatment of a flavivirus or rhabdovirus infection must, of necessity, also be patentable. Therefore, it would not be unduly burdensome to search the claims of Groups I and II.

The Examiner has not otherwise provided evidence or reasoning to dispute that a single general inventive concept links the claims of Groups I and II.

ACTION REQUESTED

Applicants submit that claims 22-30 and 39-41 share a special technical feature. Therefore, having satisfied the "unity of invention" requirement of PCT Rule 13, all of the claims of both Groups I and II should be examined in this U.S. national stage application.

The Director is respectfully requested to invoke his supervisory authority and to modify the Examiner's restriction requirement so that claims 22-30 and 38-41 are examined in this application. This would necessitate a regrouping of claims in the restriction requirement: a first Group (claims 22-30 and 38-41) and a second Group (claims 31-37).

No fee for this petition is believed to be due because the improper restriction requirement is a Patent Office error. But the Director or his designee is hereby authorized to charge any deficiency in the fee filed, or asserted to be filed, or which should have been filed herewith to our Deposit Account No. 14-1140 under Matter No. 117-363 (a duplicate copy is attached).

Applicants earnestly solicit grant of this petition. If any further information is required, the Director or his designee is invited to contact the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____

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